Appl. No. 10/796,718
Amdt. dated April 9, 2010
Reply to Office Action of October 20, 2009

PATENT

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed October 20, 2009 ("the Office Action"). Claims 1-23 and 25-26 were pending in the present application. Claims 1-23 and 25-26 stand rejected. Specifically, claims 1-23 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 7,231,427 to Qiang Du (hereinafter "Du") in view of U.S. Patent Application Publication No. 2007/0005762 by Knox et al. (hereinafter "Knox"). Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Du in view of Knox and U.S. Patent Application Publication No. 2004/0006598 by Bargagli Damm et al. (hereinafter "Bargagli Damm"). Applicants have carefully considered the Office Action and the references of record. The rejections are respectfully traversed.

In this Amendment, claims 1, 20 and 22 are amended, claims 15-19 are canceled, and claims 27-31 are newly added. In compliance with 37 C.F.R. § 1.121(f), support for all amended claims can be found in the specification (e.g., figures 1, 3B-1 and 4, and paragraphs 0037, 0063, 0070 and 0080), and no new matter has been added by these amendments. In view of the following remarks, reconsideration of the rejected claims is respectfully requested.

I. Independent Claims 1 and 20 Are Allowable Under 35 U.S.C. § 103

Independent claims 1 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Du in view of Knox. However, the Manual of Patent Examining Procedure (M.P.E.P.) states that, to reject a claim under 35 U.S.C. § 103 by combining prior art elements, the rejection must, at least: (1) show each feature of each rejected claim in the cited art, with the only difference between the claim and the cited art being the lack of actual combination of the features in a single prior art reference; (2) show that one of ordinary skill in the art at the time the invention was made could have made the proposed combination by

known methods, and that, in combination, each feature merely performs the same function as

it does separately; and (3) show that one of ordinary skill in the art at the time the invention

was made would have predicted each result of the proposed combination.

> [The rejection] **must** articulate the following:
>
> (1) a finding that the prior art included **each** element claimed ... with the **only** difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
>
> (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element **merely** performs the **same** function as it does separately; [and]
>
> (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

(M.P.E.P. § 2143(A), emphasis added). As shown below, the rejection of each claim 1 and

20 under 35 U.S.C. § 103 in the Office Action is deficient in one or more of these respects

and therefore fails to establish a prima facie case of obviousness.

Independent claim 1 is directed to "a method for facilitating and tracking e-mail

communications between (i) an end user ... and (ii) an external contact." The method of

claim 1 includes "sending an initial e-mail message ... to the external contact." The "initial

e-mail message" includes "a tracking string encoding tracking information." Independent

claim 1, as amended, requires that the tracking string include "a first tracking string

component ... and a second tracking string component." The "first tracking string

component" is required to "[identify] a thread of conversation between said end user and said

external contact." The "second tracking string component" is required to "[order] messages

in the thread of conversation."

On page 4, the Office Action admits that Du does not teach or suggest the "tracking

string encoding tracking information" required by claim 1. The Office Action then cites

Knox, ¶ 0006-0007, as teaching "inserting a tracking code into an email." However, as is

made clear by the amendment made to claim 1 herein, Knox does not teach or suggest the

"tracking string encoding tracking information" required by claim 1. Knox, ¶ 0006, states

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"the tracking code is uniquely associated with the outgoing email, each individual recipient of the outgoing email (in the case where the outgoing email is addressed to multiple individuals, for example, using the "cc" field of an email), the sender of the outgoing email, or the sender's business association, or a combination thereof." In contrast, the "tracking string encoding tracking information" required by independent claim 1 requires "a first tracking string component uniquely identifying a thread of conversation between said end user and said external contact and a second tracking string component that orders messages in the thread of conversation."

As with claim 1, independent claim 20 is directed to "a method for facilitating and tracking e-mail communications between (i) an end user … and (ii) an external contact." Furthermore, the method of claim 20 includes "sending an initial e-mail message … to the external contact," and requires that the "initial e-mail message" includes "a tracking string encoding tracking information." Independent claim 20, as amended, requires that the encoded tracking information include "a first tracking information component … and a second tracking information component." The "first tracking information component" is required to "[identify] a thread of conversation between said end user and said external contact," and the "second tracking information component" is required to "[order] messages in the thread of conversation."

On page 9, the Office Action rejects claim 20 "for the same reasons given in the rejection of [claim 1]." However, as is made clear by the amendment made to claim 20 herein, Knox does not teach or suggest the "tracking string encoding tracking information" required by claim 20. In contrast to the "tracking code" of Knox, the encoded "tracking information" required by independent claim 20 requires "a first tracking information component uniquely identifying a thread of conversation between said end user and said external contact and a second tracking information component that orders messages in the thread of conversation."

For at least the above reasons, no combination of Du and Knox teach or suggest each and every feature of independent claims 1 and 20 as amended. The standing rejections of unamended claims 1 and 20 thus fail to establish prima facie cases of obviousness with respect to independent claims 1 and 20, as amended. Accordingly, Applicants request that the rejections of claims 1 and 20 under 35 U.S.C. § 103 be withdrawn.

II.   Dependent Claims 2-14 and 21-26 Are Allowable Under 35 U.S.C. § 103

Claims 1 and 20 are in independent form, whereas each of the claims 2-14 and 21-26 depend on one of the independent claims 1 and 20. The dependent claims are patentable for at least the same reasons that the independent claims are patentable in that the dependent claims incorporate each of the features of the independent claim from which they depend. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Additional reasons for the patentability of the dependent claims 2-14 and 21-26 exist, and Applicants reserve, without prejudice, the right to provide these reasons at a later date.

III.   Canceled Claims 15-19

Claims 15-19 are canceled herein for administrative reasons having no bearing upon the merits of the claimed subject matter. Applicants reserve, without prejudice, the right to prosecute same and similar claims at a later date.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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